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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEN, CHONGSHAN

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,678

Applicant(s)

LAWTON, SCOTT S.

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>9/1/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to amendment filed on 3 June 2004. Claims 1-28 are canceled, and claims 29-56 have been added as new claims. Claims 29-56 are pending and presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 29-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Independent claim 29 recites the limitation "A system that assembles sort criteria for an information sorting mechanism" in claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear what kind of system is the system, whether the system is a computer system or a mechanical system or other kind of system.

Independent claims 52, 53 and 56 are rejected on grounds corresponding to the reasons given above for claim 29.

Claims 30-51 and 54-55 are depend on rejected independent claims 29 and 53.

5. Regarding claims 29, 52, 53 and 56, the term "optional" in the phrases "optional primary sort criteria" and "optional secondary sort criteria" renders the claims indefinite. If the primary and secondary sort criteria are optional, then the system has choice either to receive the sort

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criteria or not to receive the sort criteria. It is unclear whether the system receives or does not receive the sort criteria. Corrections are required for all other similar problems in other claims.

6. Regarding claims 29, 52, 53 and 56, the term "may" in the phrases "may include the entire secondary sort criteria" renders the claims indefinite. The term "may" is a conditional term. It is unclear whether the system includes the entire secondary sort criteria or does not include the entire secondary sort criteria. Corrections are required for all other similar problems in other claims.

7. Claims 29 and 56 recites the limitation "the benefit" in the second to last line of the claims. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 30 recites the limitation "the default list" in the second to last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Corrections are required for all other lack of antecedent basis in claims 29-56.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV. B.2. (b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical

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transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 29-56, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Response to Arguments

10. Applicant's arguments, see page 11, filed on 28 May 2004, with respect to the rejection(s) of claim(s) 1-6 under 103(a) have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Freund et al. (US 5809497). AddressPro does not explicitly disclose a secondary sort criteria which is not received from the user. Freund teaches a default sort criteria (Freund, col. 13, lines 63-65), which is not received from the user.

Furthermore, Freund teaches the user can specify additional sort criteria and merge the additional sort criteria with the default sort criteria (Freund, col. 13, lines 63-65). This will allow the system not only to obtain the benefit of the default sorting, but also track user specified additional sort criteria and sort data according to the user's preference in addition to the default sorting order.

11. As per applicant's arguments regarding AddressPro does not include implied data elements as part of the sort have been considered but are not persuasive. AddressPro teaches the

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user is allowed to choose any field to be the main sorting & display field (first name, home phone, fax, address, city ... and, of course, company or last name) (AddressPro, 1. Overview). Since the AddressPro states the user is allowed to choose any field as the sort criteria, the user can use the home phone, address, city as the sort criteria. The data element home phone or address implies the city because if we know the home phone or address, we will know the city. Clearly, AddressPro includes implied data elements as part of the sort.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 29-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over AddressPro (AddressPro v4.0 (c) Copyright January 2000 by ZingWare).

As per claim 29, AddressPro teaches a system that assembles sort criteria for an information sorting mechanism, the system comprising:

receive optional primary sort criteria, the primary sort criteria comprising every sort criteria specified by a user, the primary sort criteria comprising an instruction list containing at least one data element identifier (AddressPro, 6.2, Changing the display and sort order of the address list, the user enters sort instructions);

receive the secondary sort criteria (AddressPro, 6.2, Changing the display and sort order of the address list, secondary sort field),

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create the adapted list by merging the instruction list with relevant portions of the secondary sort criteria which may include the entire secondary sort criteria (AddressPro, 6.2, Changing the display and sort order of the address list, "the secondary sort field is used to sort the list if the records has the same data in the main sort field". Clearly, the sorting method merges the secondary sort field with the main sort field), and

send the adapted list to the output port (AddressPro, 6.2, Changing the display and sort order of the address list, display).

AddressPro teaches a main sort criteria and secondary sort criteria, but does not explicitly disclose one of the sort criteria is not received from the user. Freund teaches a default sort criteria (Freund, col. 13, lines 63-65), which is not received from the user. Furthermore, Freund teaches the user can specify additional sort criteria and merge the additional sort criteria with the default sort criteria (Freund, col. 13, lines 63-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the main sort criteria of AddressPro as a default sort criteria so that the system not only to obtain the benefit of the default sorting, but also track user specified additional sort criteria and sort data according to the user's preference in addition to the default sorting order.

Neither AddressPro nor Freund explicitly discloses an instruction port, a secondary port and an output port. However, a port is an interface through which data is transferred between a computer and other devices (such as a printer, mouse, keyboard, or monitor), a network, or a direct connection to another computer (Microsoft Computer Dictionary). It is obvious the AddressPro or the system of Freund includes all the ports so that the sort/display system can receive sort instructions from the user, sort and display the address list. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to include an instruction port, a secondary port and an output port in the system of AddressPro or Freund so that the sort/display system can receive sort instructions from the user, sort and display the address list.

As per claim 30, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the secondary sort criteria includes a default list having at least one data element identifier; and the filter assembles the adapted list consisting of the contents of the instruction list followed by each of the identifiers from the default list that are not in the instruction list (Freund, col. 13, lines 63-65).

As per claim 31, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the secondary sort criteria includes at least one explicit data element identifier with associated implied criteria; each implied criteria comprising at least one implied data element identifier; and the filter assembles the adapted list by starting with an empty adapted list, iterating through the instruction list, and, for each item in the instruction list adding, without regard to order, one or both of the item itself and the implied data element identifiers that is associated with the item (AddressPro, 6.2, Changing the display and sort order of the address list).

As per claim 32, AddressPro and Freund teach all the claimed subject matters as discussed in claim 31, and further teach the filter first adds the implied data element identifiers and then adds the item (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

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As per claim 33, AddressPro and Freund teach all the claimed subject matters as discussed in claim 32 except for explicitly disclosing the implied data includes at least one of the following: City IMPLIES Area Code; City IMPLIES State; City IMPLIES Province; City IMPLIES Country, State; City IMPLIES Country, Province; State IMPLIES Country; Company Name IMPLIES IsRecruitingAgency; and/or Job Title IMPLIES IsContractPosition. However, the database in AddressPro includes city and phone number which includes area code. It is obvious the city information implies area code so that the information can identify which state the city is in. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implied data in order to identify which state the city is in.

As per claim 34, AddressPro and Freund teach all the claimed subject matters as discussed in claim 31, and further teach the filter first adds the item and then adds the implied data element identifiers (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

Claim 35 is rejected on grounds corresponding to the reasons given above for claim 33.

As per claim 36, AddressPro and Freund teach all the claimed subject matters as discussed in claim 31, and further teach the filter adds the implied data element identifiers and does not add the item (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

Claim 37 is rejected on grounds corresponding to the reasons given above for claim 33.

As per claim 38, AddressPro and Freund teach all the claimed subject matters as discussed in claim 31, and further teach the filter does not add a data element identifier to the

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adapted list if the adapted list already contains the identifier (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 39, AddressPro and Freund teach all the claimed subject matters as discussed in claim 3, and further teach the filter adds every implied data element identifier that is implied by any implied data element identifier (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 40, AddressPro and Freund teaches all the claimed subject matters as discussed in claim 29, and further teaches the secondary sort criteria includes a default list having at least one default data element identifier and at least one explicit data element identifier with associated implied criteria; each implied criteria containing at least one implied data element identifier; and the filter assembles the adapted list by starting with an empty adapted list and: iterating through the instruction list, and, for each item in the instruction list adding to the adapted list, without regard to order, one or both of the item itself and any implied data element identifiers associated with the item; and appending to the adapted list each data element identifier from the default list that is not in the adapted list (Freund, col. 13, lines 63-65, AddressPro, 1. Overview, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 41, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teaches a control port configured to receive an optional command; and wherein the filter reads the command from the control port, and, if the command indicates that the secondary sort criteria should not be used, the filter creates an adapted list identical to the instruction list (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

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As per claim 42, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the information sorting mechanism is comprised of a database, a database management system, a search engine supporting full-text search and sorting by data elements within the text, or a sorting library or code module (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 43, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach each data element is comprised of a database field, tagged data including HTML, XML, or SGML, meta data, or a document (AddressPro, 1. Overview, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 44, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the secondary port is comprised of static data stored in a storage means (AddressPro, 1. Overview, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 45, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the secondary port is configured to interact with code; and wherein the filter is configured to invoke the code in a procedural, object-oriented or other programmatic fashion (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list, the examiner interprets the "and/or" as or).

As per claim 46, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teaches the instruction port is coupled to an HTTP Web server, or coupled to a computer-readable media, or configured to communicate via a standard electronic

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messaging protocol (AddressPro, 1. Overview, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 47, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the output port is configured to interact with code; and wherein the filter is configured to invoke the information sorting mechanism in a procedural, object-oriented or other programmatic fashion (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 48, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the system is implemented as a script embedded in, or linked to, a document employing a markup language including HTML, XML or SGML (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 49, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the system is implemented as a desktop, client-server, or n-tier application (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 50, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach the filter is further configured to translate the adaptive list to the syntax or the format of the target information sorting mechanism (AddressPro, 1. Overview, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 51, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach each data element is part of a data object, the data object

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having at least one data unit of employment information (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 52, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teach a data producer and a data consumer (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 53, AddressPro and Freund teach all the claimed subject matters as discussed in claim 29, and further teaches a data source and a search port configured to receive search criteria (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list).

As per claim 54, AddressPro and Freund teach all the claimed subject matters as discussed in claim 53, except for explicitly disclosing the data formatting employs a markup language including HTML, XML or SGML. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to format data employing HTML, XML or SGML in order to provide data using web technology.

As per claim 55, AddressPro and Freund teach all the claimed subject matters as discussed in claim 53, and further teach the contents of at least one data element of at least one data object contains employment information (AddressPro, 1. Overview, 6.2, Changing the display and sort order of the address list, display).

Claim 56 is rejected on grounds corresponding to the reasons given above for claim 29.

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Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 2, 2004


SHAHID ALAM
PRIMARY EXAMINER